

REMARKS/ARGUMENTS

Claims 1, 2, 45, 7-16 and 18-23 are currently pending. Claims 1, 2, 4, 5, 7-16 and 18-23 stand rejected. By this amendment, claims 1, 8, 16 and 22 are amended.

Withdrawal of Final Rejection

Applicant requests reconsideration as to the "Final" designation of the instant application. One section of the Office Action indicates that the rejection is non-final¹ while a different section of the Office Action indicates that the rejection is final.² To the extent that the status is considered final, Applicant respectfully submits that such final rejection is premature. Applicant requests withdrawal of such final rejection and reconsideration of the claims pursuant to the MPEP.³

The MPEP provides, in pertinent part, that second actions on the merits shall be final except where the examiner introduces new grounds for rejection that was not necessitated by the applicant's amendment.⁴ Applicant respectfully submits that the Amendment filed in response to the Final Office Action mailed February 22, 2006 did not necessitate this office action being made final.

In the Final Office Action mailed February 22, 2006, claims 1-5 and 7-20 were rejected and claim 6 was objected to as being dependent upon a rejected base claim but was found to be allowable if rewritten in independent form. Applicant amended independent claims 1 and 16 to recite all the limitations of claim six and intervening claim 3. Applicant submits that since such amendment was deemed allowable in the February 22, 2006 Final Office Action, Applicant did not introduce new grounds for rejection. Applicant therefore requests that the final rejection be withdrawn, and the instant amendments to the claims be considered.

Applicant's invention

The instant invention provides an impact resistant substrate juxtaposed in close spatial relationship to the back of the wearer's neck. The substrate provides shock

¹ Office Action, pg. 1, Status.

² Office Action, pg. 4 ¶6, lines 1-3.

³ MPEP §706.07(e).

⁴ See MPEP §706.07(a).

absorbing protection to the wearer's spine while the wearer is engaged in sports or other physical activities, said wearer who also may be wearing a helmet. The device protects the user in the event he/she falls back against a curb, rail or other protrusion during cycling, roller blading, or the like. The art of record does not anticipate or suggest the instant invention.⁵

§102(b) Rejection

Claims 1, 2, 7, 9, 14, 16 and 18-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Taylor, U.S. Patent No. 4,745,922 (hereinafter "Taylor"). Applicant traverses this rejection with respect to claims 1, 2, 7, 9, 14, 16 and 18-23 and respectfully submits that the pending claims are allowable.

Taylor Immobilizes

The Office Action provides that *Taylor* teaches "a protective neck device including a first impact resistant pliable arcuate substrate (26) adapted to encircle the neck and lower cranium with adjustable straps (32) having hook and loop material/third substrate (34) that extends from the substrate and worn about the neck..."⁶ Applicant disagrees.

Taylor does not disclose a pliable substrate. Rather, *Taylor* specifically discloses a 'rigid portion 26'⁷ so as to prevent head movement. Indeed, *Taylor* is titled as an **immobilization device**. *Taylor*'s collars "are particularly useful at the scenes of accidents and during patient extraction, and they can also be useful during other stages of treatment."⁸

Taylor teaches a cervical collar. Cervical collars must prevent head movement of any kind. As such, *Taylor* teaches away from the device as originally claimed. To modify *Taylor* to have a pliable construction and therefore allow head movement would obviate its purpose. If a prior art reference is cited that requires some modification in

⁵ See, for example, Specification, page 5, lines 18-23.

⁶ Office Action, pg. 2, ¶¶2, lines 1-4.

⁷ Taylor, col. 4, lines 4 and 27.

⁸ Taylor, col. 1, lines 8-11.

order to meet the claimed invention and such modification destroys the purpose of the invention disclosed in the reference, one of ordinary skill in the art would not find reason to make the proposed modification. In re Gordon 733 F. 2d 900 (Fed. Cir 1984).

Anticipation under 35 U.S.C. §102(b) requires "the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."⁹ Applicant disagrees that *Taylor* discloses each and every element of independent claims 1, 16 and 22 as now more clearly defined.

As discussed above, previously presented claim 1 and claim 22 recites "a first impact-resistant **pliable** substrate." Amended claim 16 also recites this limitation. This pliable limitation by itself clearly differentiates the instant invention from *Taylor*.

To further differentiate the instant device from the art of record, independent claims 1, 16 and 22 are further amended to recite a device, which allows unimpeded motion of the person's head, either side to side or front-to back while the person is wearing the device. Support for this added limitation is found on page 3, lines 19-21 of the specification. This unimpeded motion limitation is contrary to the object stated in *Taylor* (see Col 3, line 11, and line 49) of immobilizing the cervical area. See also Col 3, lines 55-57 of *Taylor* which state as follows:

"Rigid portions should also be included to reinforce the flexible portions and to support the wearer's head and neck."

Taylor does not disclose a **pliable** first impact-resistant material as provided in the instant invention. *Taylor* does not confer unimpeded head motion as provided in the instant invention. As *Taylor* does not specifically disclose each and every element of amended independent claims 1, 16 and 22, these claims are not anticipated by *Taylor* and the §102(b) rejection is overcome. Withdrawal of the rejection based on *Taylor* is respectfully solicited.

Claims 2, 7, 9, 14 and 21 depend, directly or indirectly, from claim 1; claims 18-20, depend from claim 16, directly or indirectly; while claim 23 depends from claim 22,

⁹ *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)).

and recite additional features thereto. Claims 2, 7, 9, 18-22 and claim 23 are allowable for all the reasons provided above with respect to claims 1, 16 and 22.

§103(a) Rejection

Claims 8, 10-13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Taylor*. Claims 8, 10-13 and 15 depend, directly or indirectly, from amended independent claim 1. In light of the aforementioned amendments to claim 1, applicants submit that these dependent claims are also allowable.

Claims 4-5 stand rejected under 35 U.S.C. §103(a) as being unanticipated by *Taylor* in view of *Hujar*, U.S. Patent No. 5,557,807 (hereinafter “*Hujar*”). Applicant traverses this rejection with respect to claims 4-5 and respectfully submits that the pending claims are allowable.

The Office Action provides that the suggested combination of *Taylor* and *Hujar* teaches as follows:

Taylor discloses the invention as set forth above except for showing means of attaching the neck device to a helmet. *Hujar et al* (hereinafter *Hujar*) discloses a helmet with cooling means having a neck protector that is integrally molded thereto as shown in figure 3.¹⁰

Applicant disagrees.

It is respectfully submitted that *Taylor* does not disclose the instant invention as provided previously. Rather, *Taylor* discloses neck and head immobilization collars that are useful at the scenes of accidents and during patient extraction, and may also be useful during other stages of treatment. The devices disclosed by *Taylor* are not designed to protect the user during sports or other physical activities, nor are they designed to be worn with a helmet.

The Office Action provides that the combination of *Taylor* and *Hujar* was obvious. Specifically, the Office Action provides that:

[i]t would have been obvious to one skilled in the art at the time the invention was made to position the neck device of *Taylor* which is reversibly worn on the head as shown in figure 4 by attaching the device to a helmet as taught by *Hujar*, an alternative by equivalent means of

¹⁰ Office Action, pg. 3, ¶4, lines 1-4.

securing the device about the head in order to keep the user comfortable or depending on the end user thereof.¹¹

Applicant disagrees that the suggested combination is obvious. The Federal Circuit has on a number of occasions addressed the issue of whether an alleged case of *prima facie* obviousness was properly made. “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.”¹² The mere fact that the references may be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of such combination. Thus, one cannot merely provide a statement of operability, but must explain why a person of ordinary skill would be motivated to combine the references.

Generally, the “motivation to combine or modify” references includes identifying some missing element or function that calls out for such combination or modification. Otherwise it is difficult to set forth a convincing rationale for a person of ordinary skill to be motivated to make the combination or modification, and it would appear that the claims merely are being used as a template.

Neither *Taylor* nor *Hujar* disclose, nor does the Office Action identify, any missing element or function in *Taylor* that calls for the suggested combination. The Office Action merely states that *Hujar* discloses an “equivalent means of securing the device about the head in order to keep the user comfortable or depending on the end user thereof”. Applicant submits that this is simply a statement of operability. Therefore the proposed combination is not suggested by the references

Additionally, it is well established that the proposed combination can not render the prior art unsatisfactory for its intended use.¹³ Applicant respectfully submits that combining the collar (or rigid portion 26) as disclosed by *Taylor* with the securing the device to a helmet as disclosed by *Hujar*, would render unsatisfactory for its intended

¹¹ Office Action, pg. 4, ¶5, lines 6-10.

¹² *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929, 933 (Fed. Cir. 1984).

¹³ See MPEP §2143.01 and *In re Gordon*, 733 F.2d 900, USPQ 1125 (Fed. Cir. 1984).

use (i.e., accidents, patient extraction and other stages of treatments). Applicant submits that the suggested combinations is therefore improper.

Separately, Applicant disagrees that figure 4 of *Taylor* discloses the neck device being reversibly worn as suggested previously. Rather, figure 4 simply provides a "rear plan view of the collar ..." ¹⁴

Assuming, *in arguendo*, that the individual teachings of *Taylor* and *Hujar* are indeed combinable, such a combination does not render the device of claims 4 and 5 obvious to one of ordinary skill in the art, as claimed features are lacking. Claims 4 and 5 depend from claim 1 and include all the limitations thereof. Claim 1 is amended to recite a first impact-resistant pliable substrate in combination with conferring unimpeded head movement among other features.

As *Taylor* and *Hujar* do not specifically disclose each and every element of claims 4 and 5, these claims are allowable.

An earnest attempt has been made hereby to respond to the July 3, 2006 Official Action in the above identified matter. Applicant submits that the application is now in condition for allowance. If the Examiner feels that a telephonic interview will expedite allowance, she is respectfully urged to contact the undersigned. Claims 1,2, 4, 5, 7-16, and 18-23 are pending. Allowance is hereby solicited.

Dated: November 2, 2006

Respectfully submitted,

CHERSKOV & FLAYNIK



Michael J. Cherskov
Reg. No. 33,664

20 North Wacker Drive
Suite 1447
Chicago, IL 60606
Telephone: (312) 621-1330
Facsimile: (312) 621-0088.

¹⁴ Taylor, col. 3, line 34.